

REMARKS

Claims 1 to 8 are pending. Reconsideration of the application is requested.

Request for Withdrawal of Finality of the September 29, 2008 Office Action

MPEP 706.07 states that “[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)” (emphasis added). MPEP 706.07(d) further states that “[i]f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.” Applicant respectfully requests that the Examiner withdraw the finality of the September 29, 2008 Office Action because the Examiner introduced a new ground of rejection (as Examiner admitted on page 9 of the September 29, 2008 Office Action) that was neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c).

§ 103 Rejections**Previously Made Rejections**

Claims 1, 2, 4-6, and 8 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 3,036,928 to Poole (“Poole”) in view of U.S. Patent No. 6,957,869 to Sawtelle (“Sawtelle”) and further in view of Boeing A&M Environmental Technotes, vol. 6, No. 2 (May 2001) (“Boeing”). Specifically, the Examiner admits that Poole is silent as to the marking material being temporary and the layer and microballs being thermally-expansible (Office Action, page 2). However, the Examiner states that Sawtelle describes temporary pavement markers (Office Action, page 2-3). The Examiner also states that Boeing teaches thermally-expansible microballs (Office Action, page 3). The Examiner then concludes that it would have been obvious to one of ordinary skill at the time of the invention to “modify the microballs and layer of Poole to be thermally-expansible by using thermally-expansible microballs, as taught by

Boeing. . . in order to provide the means to assist in the markers removal so that it can be easily removed” (Office Action, page 3).

Claims 3 and 7 stand rejected under 35 USC § 103(a) as being unpatentable over Poole in view of Sawtelle and further in view of Boeing and further in view of the Matsumoto website (“Matsumoto”). The Examiner admits that Poole, Boeing, and Sawtelle fail to describe the “microballs having an expandability of at least ten times in terms of volume” (Office Action, page 5). However, the Examiner states that Matsumoto describes this claim element and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine these four references.

Applicant respectfully disagrees with these rejections.

First, rebuttal evidence, within the context of a prima facie case of obviousness, is merely a showing of facts supporting the opposite conclusion, and can include evidence that the prior art teaches away from the claimed invention in any material respect. *In re Peterson*, 315 F.3d 1325, 1331 (Fed.Cir.2003). When an applicant puts forth rebuttal evidence, the Examiner must consider that evidence. *See In re Soni*, 54 F.3d 746, 750 (Fed.Cir.1995) (stating that “all evidence of nonobviousness must be considered when assessing patentability”). Applicant respectfully asserts that the Examiner improperly failed to consider applicant’s rebuttal evidence that Poole teaches away from its combination with Boeing and/or Matsumoto.

A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). To determine whether a patent claim is obvious, one must determine (1) what the prior art teaches, (2) whether it teaches away from the claimed invention, and (3) whether it motivates a combination of teachings from different references. *In re Fulton*, 391 F.3d 1195, 1199-1200 (Fed.Cir.2004). As applicant asserted in its June 9, 2008 response, Poole (1) does not describe temporary pavement markings (as the Examiner admits); (2) specifically teaches away from temporary pavement markings; and (3) because Poole specifically teaches away from temporary pavement markings, the Examiner has failed to adequately show a motivation to combine Poole with Boeing and/or Sawtelle. Poole describes permanent pavement marking materials. For example, Poole states that “[t]he final marking . . . adheres permanently to the surface on which it is

deposited” (col. 4, lines 33-34 (emphasis added) see also, col. 2, lines 56-57; col. 4, lines 60-64; and col. 6, lines 14-16). Further, Poole states that one problem with the prior art was that “the marking[s] of the prior art] will wear off easily” (col. 1, lines 49-51). Because Poole explicitly teaches away from temporary pavement markings and emphasizes the importance of permanent pavement markings, one of ordinary skill in the art would not think of ways to make the pavement markings of Poole temporary. As such, the Examiner has failed to show the requisite motivation to combine the microballs of Boeing with the pavement markings of Poole.

Additionally, Boeing is non-analogous art whose teachings are inapplicable to the claims of the present application for various reasons. First, Boeing only describes the use of microspheres in connection with fiberglass floor grates and stainless steel frames (Boeing, pages 1-2). All of the materials to which microspheres are attached in Boeing are removable, indoor materials. In contrast, the claims 5-8 of the present application recite “pavement” which is a non-removable, outdoor surface. Second, Boeing only describes removing the floor grates or frames and soaking them in a tank or running them through a high temperature oven (pages 1-2). In contrast, the present claims refer to non-removable pavement that has to be heated and treated in situ. Third, the microballs of Boeing must be heated to at least 195°F (page 1). In contrast, the present application describes microballs that are heated to between about 80°F and about 150°F, more preferably between 100°F and 150°F (page 7, lines 16-20) and specifically states that for temperatures higher than 150°F, gas can be generated, which may be dangerous (page 7, lines 19-21). Further, pavement expands in heat. Were pavement to be heated to 195°F, as is described in Boeing, it may crack, destroying the pavement surface. Because Boeing is non-analogous for at least the reasons described above, those of ordinary skill in the art at the time the invention was made who were working in the area of pavement markings would not be motivated to use the teachings of Boeing to modify the pavement marking of Poole. Further, Poole specifically relates to the art of permanent pavement markings, and one of skill in the art of permanent pavement markings would not be motivated to look at art in the area of paint booth grates and fiberglass floor grates.

Applicant believes that the rejections of independent claim 1 under 35 USC § 103(a) as being unpatentable over Poole, Sawtelle, and Boeing have been overcome and should be withdrawn. Claims 2-8 add additional features to claim 1 and should also be allowable.

New Rejection

Claims 1, 2, 4-6, and 8 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0012599 to Wallgren et al. ("Wallgren") in view of Boeing (with regard to claims 1 and 5) and further in view of Matsumoto. More specifically, the Examiner admits that Wallgren does not describe the use of thermally-expansive microballs, but asserts that Boeing "teaches it to known to remove materials, such as paint, from a surface using thermally-expansible microballs" (Office Action at p. 6). The Examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the temporary marking material of Wallgren with the thermally expansible microballs of Boeing.

Applicant respectfully disagrees with this rejection.

Wallgren mentions temporary pavement marking materials twice. In paragraph 26, Wallgren states "[d]rop-on beads are often used for temporary road surfacings which can be removed after use, for example for traffic diversions. Such a road surfacing need only be provided with a reflecting surface sheet since there is not enough time for it to become worn to any great extent. It is of course also possible to use a road surfacing which comprises premix material in combination with drop-on material." In paragraph 36, Wallgren states "[t]he reinforcing sheet means that handling of the marking is greatly improved before application. For example, at low temperatures, there is less risk of the material breaking apart during handling. The reinforcing sheet also makes it possible to manufacture the road marking as a temporary marking, i.e. the product can be removed from the receiving surface before the marking has become worn. This type of product is preferably used for traffic diversions and similar areas." The Examiner's combination of Wallgren and Boeing fails because the Examiner has failed to show any motivation to combine the microballs of Boeing with the temporary pavement markings of Wallgren. Additionally, as is described in detail above, Boeing is non-analogous art whose teachings are inapplicable to the claims of the present application and to Wallgren for various reasons.

The rejection of independent claim 1 under 35 USC § 103(a) as being unpatentable has been overcome and should be withdrawn. Claims 2-8 add additional features to claim 1 and should also be allowable.

In view of the above, it is submitted that the application is in condition for allowance.

Respectfully submitted,

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